

REMARKS

Claims 1-3 and 5-11 are pending in this application. Claims 6-8 are withdrawn pursuant to a requirement for restriction. By this response to the non-final Office Action dated March 26, 2008, claims 1-3, 5, and 9 are amended, and claim 4 is canceled without prejudice. Support for the amendments is found in the originally filed specification and claims. No new matter has been introduced. Favorable reconsideration of the application in light of the foregoing amendments and following comments is respectfully solicited.

Objection to Claim 2

In section 2 of the Office Action, claim 2 was objected to as reciting “the surface roughness of said base” without antecedent basis. Applicants have adopted Examiner’s suggestion, and amended claim 2 as proposed. Thus, Applicants respectfully request withdrawal of the objection.

Rejection Under 35 U.S.C. § 112, ¶ 2

In section 4 of the Office Action, claim 4 was rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. Specifically, the Office Action asserted that as to the previously recited “depth of a defective portion” it was “unclear . . . how the defective portion can be controlled.” Applicants respectfully traverse.

Although the original rejection of claim 4 is moot due to the cancellation of claim 4, related limitations have been added to claims 1 and 9. Specifically, the claims 1 and 9 each recite that “the thickness of said electrically insulating film is no less than 3/2 of the depth of a defective portion included in the semiconductor device,” to clarify control of the thickness of the

electrically insulating film. Applicants respectfully submit that this new language conforms to 35 U.S.C. § 112 second paragraph.

Rejections Under 35 U.S.C. § 103(a)

In section 6 of the Office Action, claims 1, 5, and 9 were rejected under 35 U.S.C. § 103(a) as unpatentable over JP Patent App. Pub. No. 2003-007895 (Nagase). In section 7 of the Office Action, claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nagase in view of JP Patent App. Pub. No. H09-107057 (Shiraishi). Applicants respectfully traverse.

Independent claims 1 and 9 each recite, *inter alia*, that

the thickness of said electrically insulating film is no less than $\frac{3}{2}$ of the depth of a defective portion included in the electrically insulating film.

The Office Action did not assert, nor do Applicants find, that these limitations were disclosed or suggested by Nagase and Shiraishi, either individually or in combination with each other. As discussed in paragraphs [0045] and [0067] of this application, and also illustrated by the experimental results shown in Tables 1 and 2 of this application, the recited limitations are not mere design variations, but provide effects recognized by the Applicants which would have been unexpected to one of skill in the art at the time of invention in view of the Nagase and Shiraishi references.

For at least the above reasons, claims 1 and 9 as a whole would not have been obvious at the time of invention, at least with respect to the above limitations. Thus, Applicants respectfully request withdrawal of the rejections of claims 1 and 9, as well as dependent claims 2, 3, and 5, as “dependent claims are nonobvious if the independent claims from which they depend are nonobvious.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

Conclusion

In view of the above remarks, Applicants respectfully submit that the application is in condition for allowance, and respectfully request the Examiner's favorable reconsideration as to allowance, and withdrawal of any rejections of the pending claims. The Examiner is invited to contact the Applicants' representative listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Brian K. Seidleck
Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BKS/EMS:cac
Facsimile: 202.756.8087
Date: June 26, 2008

**Please recognize our Customer No. 20277
as our correspondence address.**